

REMARKS

STATUS OF CLAIMS

Claims 27-29 and 45-47 were pending in the application. Since no claims have been added or cancelled, claims 27-29 remain pending and are submitted for reconsideration by the examiner.

OBJECTION TO THE DECLARATION

Applicants note the objection to the Declaration and are making diligent efforts to contact the inventors. However, one of the inventors has not yet been located. Applicants will submit supplemental Declaration as soon as the unavailable inventor is located and if not, will submit a petition under Rule 1.183 together with a supplemental Declaration signed by the remaining inventors as per the procedure outlined in MPEP §409.03.

PRIOR ART REJECTION UNDER 35 USC § 103

In the final office action, claims 27, 28, and 45 were rejected under 35 USC § 103 as being unpatentable over U.S. Patent Number 6,049,831 to Gardell *et al.* (hereafter “Gardell”) in view of U.S. Patent Number 5,493,638 to Hooper *et al.* (hereafter “Hooper”). Claims 29, 46, and 47 were rejected under 35 USC § 103 as being unpatentable over U.S. Patent Number 5,828,370 to Moeller *et al.* (hereafter “Moeller”) in view of Hooper. Applicant respectfully traverses these rejections for at least the following reasons.

With respect to independent claim 27, even if the modification or combination of Gadell and Hooper was proper (which applicant maintains as being improper), such combination does not disclose or suggest each and every element of claim 27. For example, the combination does not disclose or suggest, among other things, a first

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compressed video stream that has overlaid thereon additional compressed video data that includes at least one control corresponding to an interaction layer. As such, the combination of Gardell and Hooper cannot disclose or suggest a client interactive TV system that decompresses both the first and additional compressed video streams and displays the WWW page and the at least one control. Further, the combination does not disclose or suggest detecting an interaction of a user with the at least one control that indicates a selection of one of an identified one or more TV channels, and in response to the user interaction, receiving and displaying the selected one of the identified TV channels on the client interactive TV system, as recited, *inter alia*, in claim 27.

Gardell discloses a system for transmitting network related information where requested network information is separately transmitted as definitions and display information. Although Gardell discloses sending Web pages to a set top box by translating a portion of a page into an MPEG I-Frame for transfer over a first path 138, Gardell does not disclose that such MPEG stream has overlaid thereon an additional compressed video data stream associated with an interaction layer. In fact, Gardell discloses that the interactive elements are transmitted as HTML UI definitions over a separate path as the video stream. Accordingly, Gardell cannot possibly disclose or suggest a first compressed video stream that has overlaid thereon an additional compressed video stream that includes at least one control corresponding to an interaction layer. Recognizing some of the deficiencies of Gardell the Office Action cites Hooper.

However, Hooper discloses a remote display of an image by transmitting compressed video frames representing background and overlay portions thereof. Unlike Applicants' claimed invention, however, Hooper discloses that interactive images are created and encoded as MPEG P-frames, which are then saved as an ordered list with the background I- frames to ensure correct reconstruction of the remote display image. See e.g., col. 6, 1. 54 - col. 7, 1. 9 of Hooper. Because the frames for both the background and the interactive images are arranged in order as a single stream, Hooper cannot possibly disclose or suggest a first compressed video stream that has overlaid thereon an

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additional compressed video stream that includes at least one control corresponding to an interaction layer. As such, Hooper cannot overcome those deficiencies noted above with regard to Gardell.

For at least the foregoing reasons, Applicants respectfully submit that the Office Action has not established a *prima facie* case of obviousness with regards to claim 27. Accordingly, Applicants respectfully request withdrawal of rejection of claim 27 as allegedly unpatentable over the combination of Gardell and Hooper.

With respect to independent claim 29, Applicants respectfully submit that Moeller does not render this claim anticipated or otherwise unpatentable for at least the reason that Moeller does not disclose or enable each and every element of claim 29. For example, Moeller does not disclose or enable overlaying a first compressed video stream with a second compressed video stream representing an interaction layer that includes at least one control that corresponds to modifications that can be made to the first compressed video stream. Note that the second compressed video stream is overlaid on the first compressed video stream without decompressing the first compressed video stream. Accordingly, Moeller cannot possibly disclose or enable modifying at least the first compressed video stream responsive to received interaction of a user with the at least one control by at least one of: changing a channel over which the client system receives compressed video and such that the client receives new compressed video, or providing the client access to a different set of P frames than were originally provided in the first compressed video stream, as recited, *inter alia*, in claim 29.

Moeller discloses a video delivery system and method for displaying an indexing slider bar on the subscriber video screen. The slider bar icon displayed is used for interactively indexing different positions of a movie video stream. Although Moeller discloses transmitting the slider bar graphical icon in conjunction with the movie video stream being output, Moeller is silent with exactly how this transmission occurs. See, e.g., Moeller col. 7, 11. 58-61. More specifically, Moeller gives no indication as to whether or not such interactive slider bar is even converted to a compressed video stream.

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Nevertheless, even if Moeller implicitly discloses that the interactive slider bar is converted to a compressed video stream, Moeller would still be *silent* as to whether or not the compressed video stream for the slider bar is separate from the compressed video for the subscribed movie being displayed. As such, Moeller cannot possibly disclose or enable overlaying a first compressed video stream with a second compressed video stream representing an interaction layer that includes at least one control that corresponds to modifications that can be made to the first compressed video stream, the second compressed video stream being overlaid on the first compressed video stream without decompressing the first compressed video stream, as recited, *inter alia*, in claim 29.

In this regard it should be noted that silence in a reference is not a proper basis for asserting obviousness based on that reference because that turns the process of examination on its head. The Patent Office (PTO) has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

Accordingly, the final office action fails to make a *prima facie* case of obviousness with respect to the pending independent claims. Accordingly, the pending independent claims are patentable over the applied prior art.

DEPENDENT CLAIMS

The dependent claims are deemed to be patentable at least based on their dependence from allowable independent claims. In addition, they recite patentable subject matter when considered as a whole.

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COMMENTS ON “RESPONSE TO ARGUMENTS” (Page 2 of Final Office Action)

The final office action asserts that for Gardell to teach away from the claimed invention, it would have to state that something is not possible even when it explicitly only teaches the opposite result. This logic is analogous to using *silence* in a reference with respect to a certain feature as a basis for asserting that the reference may teach that certain feature. This logic is expressly prohibited by applicable law. As stated earlier, the PTO has the burden of proving each of the claimed features is shown by the prior art. An allegation that claimed subject matter is “obvious” (as here alleged) requires a positive, concrete teaching in the prior art, such as would lead a person skilled in the art to choose the claimed combination from among many that might be comprehended by broad prior art teachings. The PTO’s review court has made it very clear that silence in a reference is hardly a substitute for clear and concrete evidence from which a conclusion of obviousness might justifiably flow. See, e.g., *Application of Burt*, 356 F.2d 115, 121 (CCPA 1966).

Accordingly, applicants respectfully submit that there is no proper motivation (other than impermissible hindsight) to combine Gardell and Hooper in the manner proposed by the final office action and, furthermore, even the combination does not disclose all the claimed features recited in the pending independent claims.

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CONCLUSION

Accordingly, applicant submits that the application is now in condition for allowance and an indication of the same is respectfully requested. If the Examiner believes that the application is not in condition for allowance, the Examiner is respectfully requested to call the Applicants' representative at the telephone number listed below.

If this Amendment is not considered timely filed and if a request for an extension of time is otherwise absent, Applicant hereby requests any necessary extension of time. If there is a fee occasioned by this Response, including an extension fee that is not covered by an enclosed check please charge any deficiency to Deposit Account No. 50-0463.

Respectfully submitted,
Microsoft Corporation

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<input checked="" type="checkbox"/>	CERTIFICATE OF MAILING OR TRANSMISSION		
I hereby certify that this correspondence is being electronically deposited with the USPTO via EFS-Web on the date shown below:			
Signature	<u>Aaron C. Chatterjee</u>		
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